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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,049	02/02/2004	John N. Gross	JNG 2004-5	1525
23694	7590	09/09/2005	EXAMINER	
J. NICHOLAS GROSS, ATTORNEY AT LAW 726 DUBOCE AVE. SAN FRANCISCO, CA 94117			RUHL, DENNIS WILLIAM	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/771,049		GROSS, JOHN N.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Dennis Ruhl		3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____   | 6) <input type="checkbox"/> Other: ____                                     |

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

A. Claims 1-18 drawn to a method of notifying a subscriber of activity in a rental queue.

B. Claims 19,20, drawn to a system and method of distributing media electronically.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Nicholas Gross on 7/20/05 a provisional election was made without traverse to prosecute the invention of A, claims 1-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 19,20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-18 are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

1. Whether the invention is within the technological arts; and
2. Whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere idea in the abstract (i.e. abstract ideas, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to

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promote the "progress of science and the useful arts" (i.e. physical sciences as opposed to social sciences for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, use or advance the technological arts.

In the present case, the claims do not recite or require the use of any technology and are not considered to be reciting an invention that is in the technological arts. All of the recited steps could be done by a person visually looking at a list of items on paper and verbally notifying a subscriber of queue activity. The claim has a scope that is broad enough to include just defining a set of notification rules and monitoring the queue, because if an affirmative determination is not found, no notification is sent out. In this case, the steps of defining notification rules and just monitoring the queue does not appear to be statutory. Nothing is being manipulated or changed from one state to another, all that is done is monitoring with nothing further required. The claims are not in the technological arts and are considered to be non-statutory.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2,4,7,8,9, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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For claim 2, while negative limitations are allowed to be in claims, in the present case, all that is claimed is what the notification does not do. Claim 2 appears to be solely a negative limitation that is indefinite because the examiner does not know what is positively being claimed. Method claims are supposed to recite positive manipulative steps and positive structure. Applicant has claimed what the notification does not do but has failed to recite what it does, so this claim is found to be indefinite. As an example, if someone were to claim "An article, comprising: not a chair.", you would have no idea what was being claimed because nothing is claimed about what is there, just what is not.

For claim 4, there is no antecedent basis for "the subscriber delivery queue".

For claims 7,8, it is not clear to the examiner what is meant by the term "associated". What does it mean to recite that the trigger even "is associated ..."? It is not clear what applicant is intending to claim in these claims.

For claim 9, because it has not been claimed that any determination is being made, how can the step of claim 9 take place. Claim 8 recites that the trigger is associated with a determination but applicant never claimed that a determination is in fact being made. The determination must be claimed as happening before the step of claim 9 can take place.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4,6-17, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings et al. (6584450) in view of Pennell et al. (6874023).

For claims 1,3,4,6,17, Hastings discloses a method for renting items where the customer sets up a rental queue. A set of queue replenishment rules are employed to determine if the ordering of the titles in the queue should be changed. When a DVD is returned (a trigger) the system checks the queue rules (Max Out option and/or Max Turns) to determine if the ordering of the queue should be changed. When a new DVD is shipped, the ordering of the queue is changed because that title is taken out of the queue and is then in a checked out status. Not disclosed is a set of notification rules that will notify the subscriber when the ordering of the queue has been changed by monitoring the queue. Pennell discloses a system and method where a customer that has an account with a particular web site can be notified of any changes in their account. Pennell discloses changes such as miles being added to a Frequent Flyers account or trades being made at eSchwab (online trading). Pennell recognizes that it may be too time consuming for the customer to continually log into their account at the respective web site and discloses that the notification system makes this process much easier and more user friendly. It would have been obvious to one of ordinary skill in the

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art at the time the invention was made to provide the subscriber of Hastings with the ability to monitor their queue and receive notifications when changes are made as disclosed by Pennell (identify items that are being shipped and informing them that the order of the queue is changed) so that the customer does not have to continually log into their account to be informed of account changes.

For claim 2, the notification itself would not cause any change in the queue to happen. This satisfies what is claimed.

For claims 7,8,9, because the examiner is not clear as to what is meant by "associated", as best understood by the examiner the rejection satisfies what is claimed. The trigger even can be considered as associated with what is claimed because it is not known what exactly this means.

For claims 10,11, Hastings discloses a movie recommendation system. When movies are recommended this can be taken as a suggestion to add them to the queue because that is the reason they are being suggested to the subscriber.

For claim 12, not disclosed is the receiving of feedback. It would have been obvious to one of ordinary skill in the art to solicit and receive feedback on the movie recommendation system so that you can improve it and make it more accurate to what the customer actually likes. Customer feedback is nothing new.

For claim 13, if the subscriber desires to do so, they can stop the receiving of notifications concerning their rental queue. They can have the notifications stopped. The prior art is fully capable of what is claimed.



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For claims 14-16, Hastings discloses movies. With respect to the recitations about how the movies are distributed, because no distribution of anything is being claimed the examiner has given this language minimal patentable weight. All that is claimed is that the playable media is movies.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. "Netflix Freak 1.0", and "DVD rental system" are relevant to what is claimed. With respect to the DVD rental system, the examiner is not clear as to the date that this software was being used in the public domain. The examiner does note that this software does have an "empty queue" notification feature. The examiner attempted to find a prior art date for this reference or a release date for the software but was not successful.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'D. Ruhl', with a stylized, flowing script.

**DENNIS RUHL  
PRIMARY EXAMINER**